

Application No.: 10/797,195**Docket No.: 30980107-15 US CON (1509-219A)****REMARKS**

Applicants submit herewith a terminal disclaimer to obviate the double patenting rejection of claims 1 and 14-38 based on U.S. Patent 6,776,343.

Applicants note that claims 20-30 and 35-38 are indicated as containing allowable subject matter and would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims and upon filing of a terminal disclaimer. Because the terminal disclaimer is submitted herewith, claims 20-30 and 35-38 are now allowable, subject to being rewritten in independent form. Because the claims upon which claims 20-30 and 35-38 depend are improperly rejected, claims 20-30 and 35-38 have not been rewritten in independent form.

The Examiner is requested to change the numbering of the second claim appearing on page 10 of the Primary Amendment so that the number of the claim is "38" instead of "36." The Examiner is requested to make this change by Examiner's Amendment because the Rules of Practice do not permit the applicant to change the numbering of the claims.

Claims 1, 14, 15 and 19 have been amended for clarity and to correct syntax, as well as antecedent problems.

Applicants traverse the rejection, under 35 USC 103 (a), of claims 1, 14-19 and 31-34 as being obvious over Smith et al., U.S. Patent 5,455,409, in view of Ruppert et al., U.S. Patent 5,640,002.

Initially, applicants note there is no treatment of method claims 15-18 or 31-34 in the office action.

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Independent method claim 15 is directed to a method of enabling personnel to determine information about data stored in a memory structure of a housing having a data storage structure storing signals indicative of the information, i. e., the information about the data stored in the memory structure. The method includes the steps of carrying by hand a hand holdable portable reader for the signals stored by the data stored structure. The hand holdable portable reader includes a printer. The data storage structure is inserted into a port of the portable reader. While the data storage structure is inserted in the port the reader is caused to read the stored signals indicative of the information from the data storage structure. The printer of the reader is caused to print a label including the information in human readable form in response to the stored signals read by the reader. The printed label including the information in human readable form is attached to the housing.

The foregoing steps of claim 15 are important in resolving the problem discussed in the application as filed, as set forth on page 3, line 9 - page 5, line 7. These problems concern the inconveniences associated with the prior art, as included in the Smith et al. mainframe computer-based magnetic tape library system patent relied on by the Examiner. The problems are summarized on page 4, lines 26 and 27, where it is indicated that a mainframe computer-based magnetic tape library arrangement of the type disclosed by the Smith et al. patent may require 10 to 15 minutes to print a label for a magnetic tape data cartridge.

Applicants cannot agree that one of ordinary skill in the art would have modified Smith et al. as result of Ruppert et al. to arrive at the foregoing steps defined by claim 15. Ruppert et al. is concerned with a portable barcode and RF ID tag reader for

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gathering information about items to be purchased by a consumer. The device is for assisting shoppers in creating shopping lists, determining products purchased and keeping totals of amounts spent and items from shopping lists that have been picked up; see column 1, lines 20-24. Hence, Ruppert et al. has nothing to do with libraries of magnetic tapes or other storage media associated with a data processing center, i. e., the subject matter of the Smith et al. patent. As result, one of ordinary skill in the art would not have looked to Ruppert et al. in connection with the Smith et al. magnetic tape library system. The Examiner, in combining Smith et al. and Ruppert et al. has cast about to find references disclosing some pieces of applicants' contribution to the art. In other words, the combination of references results from an improper use of hindsight.

In addition, neither reference discloses the claim 15 requirement of carrying by hand a hand holdable portable reader for signals stored by a data storage structure that stores signals indicative of information about data stored in a memory structure of a housing including the data storage structure and the memory. Consequently, the Smith et al. and Ruppert et al. references do not disclose the claim 15 step of causing a printer of a hand holdable portable reader to print a label including information about data stored in a memory structure of a housing. Thus, the rejection is also improper because the combination of references fails to disclose all aspects of claim 15.

Claims 16-18 depend on claim 15 and are allowable therewith. In addition, these dependent claims recite features neither reference discloses.

For example, claim 16 requires a display of the hand holdable reader to respond to tactile operation of a keyboard of the hand holdable reader by a user to display to the

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user information about data stored in the memory structure of the housing including the data storage structure and the memory. In Smith et al., the display and the keyboard are part of a large computer system including, for example, mainframe computer 54. The use of mainframe computer 54 results in the problems set forth in the present application as filed on page 3, line 9-page 5, line 7. In Ruppert et al. there is no display of user information about data stored in a memory structure of a housing including the data storage structure and the memory.

Claim 17 depends on claim 16 and further requires the display of the hand holdable reader to display to the user a message requesting the user to selectively activate the printer to print a label including information about data stored in a memory structure of a housing. Claim 18 includes similar limitations, with the additional limitation of causing the display to display to the user a message requesting the user to selectively activate the printer to print the label after the display has displayed the information. The Smith reference does not disclose the steps because of the use of mainframe computer 54 which results in the problems set forth in the present application. In Ruppert et al. there is no display to the user of a message requesting the user to selectively activate the printer to print a label including information about data stored in a memory structure of a housing.

There is also no analysis of claim 31 in the office action. Claim 31 is directed to a method of enabling personnel to determine information about the contents of a large capacity memory carried by a housing that also carries data indicative of the information about the contents of the large capacity memory. Claim 31 requires such a housing to be inserted into a port of a portable casing, a step not disclosed by the mainframe

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computer arrangement of Smith et al. nor the consumer shopping assistant of Ruppert et al.. Based on similar rationale, neither Smith et al. nor Ruppert et al. discloses the claim 31 requirement for causing a transducer of a hand holdable portable casing to read data indicative of information about the contents of a large capacity memory carried by a housing while the housing is inserted into a port of the hand holdable portable casing. Nor does either reference disclose the requirement of claim 31 for a printer of a hand holdable portable casing to print information about the contents of a large capacity memory in human readable form in response to read data indicative of information about the contents of the large capacity memory.

Claims 32-34, dependent on claim 31, are allowable with claim 31. In addition, claim 32 requires the printer of the hand holdable portable casing to print the information about the contents of the large capacity memory in human readable form on a label that is applied to the housing. In Smith et al., such a label is apparently printed in response to operation of the mainframe computer arrangement. In Ruppert et al., no similar label is printed and there would be no reason for printing such a label in the Ruppert et al. consumer shopping assistant arrangement.

Claim 33 distinguishes over Smith et al. and Ruppert et al. by requiring the display of a hand holdable portable casing to display to a user information about the contents of a large capacity memory carried by a housing including a transducer for data indicative of the information. Display of information to a user about the contents of a large capacity memory is performed by the Smith et al. mainframe computer. Ruppert et al. has no display of any similar information. The same is true of claim 34 with regard to the combination of Smith et al. and Ruppert et al..

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Claims 1 and 14 are directed to hand holdable portable reader devices.

Claim 1 states the device is capable of reading data stored in a memory device attached to a cartridge data storage device. A signal receiver means is capable of receiving data signals emitted from the memory device and a memory means is capable of storing the data signals received by the receiver means. A processor device is operable to control a printer device to print indicia on a print media in response to data signals stored in the memory means. The printer device is configured to print, on print media, human readable indicia determined by at least some of the data signals received by the printer device. Applicants cannot agree that Smith et al. and Ruppert et al. renders the combination of claim 1 obvious to one of ordinary skill in the art because the Smith et al. mainframe computer arrangement associated with a tape library system is so different from the Ruppert et al. consumer assistant device and system that such a person would not have combined them.

Claim 14 requires the hand holdable portable reader device to include a casing having a port capable of receiving a data storage device including a memory device on a data storage device. Neither Smith et al. nor Ruppert et al. discloses such a casing port. Again, the Smith et al. and Ruppert et al. arrangements are so disparate that one of ordinary skill in the tape library system art, per Smith et al., would not look to the consumer assistant art, per Ruppert et al.

Claim 19 is also directed to a hand holdable portable device. The device of claim 19 is responsive to data on a housing carrying a large capacity memory. The data are indicative of information stored in the large capacity memory. A hand holdable portable casing includes a port for receiving the housing carrying the large capacity memory and

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the data, a limitation not found in either Smith et al. nor Ruppert et al. and not discussed in the office action. Further, one of ordinary skill in the art would not have combined Smith et al. and Ruppert et al. to meet the limitations of claim 19 because the Smith et al. and Ruppert et al. devices are concerned with fields that are so different from each other.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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